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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/673,638

09/30/2003

John D. Litvay

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT

PAPER NUMBER

3761

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	Application No. 10/673,638	Applicant(s) LITVAY, JOHN D.	
	Examiner Jacqueline F. Stephens	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed 11/3/06 have been fully considered but they are not persuasive. Applicant argues has not clearly defined the invention. Additionally, one of ordinary skill in the art would not be able to make and use the invention based on the original disclosure. For example, page 34 paragraph 00114 describes as a suitable superabsorbent "any superabsorbent polymer (SAP) now known or later discovered may be used in absorbent core 28". The specification discloses any materials suitable for the absorbent core, yet the claims are specific to performance characteristics for the core. In the independent claims, the limitations are not directed to structure or a specific composition, but rather to what the absorbent article does, therefore the claims are broad *and indefinite* for reciting only the desired physical properties of the modifying agent, rather than setting forth structural and/or chemical characteristics. Because the claim does not set forth that which applicants regard as their invention, the rejection under 35 USC 112, second paragraph is maintained.

As to the *Aleman* reference and the statement of inherency, the rejection has been made in the sense of *In re Fitzgerald*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). See MPEP § 2112- 2112.02, which states 'When the reference discloses all the limitations of a claim except a property or function, and the examiner cannot determine whether or not the reference inherently possesses properties which

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anticipate or render obvious the claimed invention but has basis for shifting the burden of proof to applicant. In this case the basis for shifting the burden of proof is that Alemany discloses similar materials and construction as the claimed invention. The burden is shifted to Applicant to show that the prior art produces a different product that would not have the claimed performance characteristics. This should be presented by the factual evidence, and in the instant case the Applicant failed to show a valid side-by-side comparison between their product and the product disclosed by the Alemany.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-65 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Claims 1-65 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims set forth the physical characteristics desired of the composite alone rather than the specific composition of the composite in the end product. Therefore, relying on Ex parte Slob, 157 USPQ 172, such claims could cover any conceivable combination of materials whether presently existing or which might be

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discovered in the future and which would impart the desired characteristic, i.e. the claims are too broad and indefinite since they purport to cover everything having the claimed characteristics regardless of its composition (It should be noted that 35 USC 101 sets forth "Whoever invents or discovers any new and useful...composition of matter...may obtain a patent therefor...title, i.e. does not include composition that have yet to be invented and discovered.).

***Claim Rejections - 35 USC § 102/103***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-69 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative under 35 U.S.C. 103(a) as obvious over Alemany et al. USPN 4834735.

Alemaný discloses an absorbent core and by description, a method of designing an absorbent core comprising a topsheet and backsheet and absorbent core between the topsheet and backsheet. . It is the examiner's first position that pages 23-30, paragraphs 0086-00104 of the specification sets forth materials capable of providing the claimed leakage performance index. Alemany teaches similar materials for the core (col. 7, line 58 through col. 9, line 28, topsheet, and backsheet). Thus, Alemany inherently includes a core capable of providing the claimed absorptive capacity and an article capable of providing the claimed leakage performance results. "When the structure recited in the reference is substantially identical to that of the claims of the instant invention, claimed properties or functions are presumed to be inherent (MPEP 2112-2112.01). A *prima facie* case of either anticipation or obviousness has been established when the reference discloses all the limitations of a claim except a property or function and the examiner can not determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but has basis for shifting the burden of proof as in *In re Fitzgerald*, 619 F.2d 67, 70 205 USPQ 594, 596 (CCPA 1980)." In the present case, the reference has met the structural requirements of the claim.

It is noted however, that Alemany does not specifically disclose the absorbent core comprises a front pad that has an absorbency under load as claimed. However, Alemany recognizes the size and concentration of materials of the absorbent core can be varied and this will affect the absorbent capacity in specific regions (col. 7, lines 57-

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67; col. 12, lines 41-59; col. 20, lines 6-68). Alemany, therefore, recognizes the absorbent capacity is a result effective variable of the materials used to makeup the core. It is the examiner's second position that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the article of Alemany with the claimed absorbent capacity, since discovering an optimum value of a result effective variable involves only routine skill in the art.

Alemany teaches the shape, size, and positioning of the acquisition zone (insult point) is important with respect to the rapid acquisition of fluids and the point should be positioned with respect to the area of typical liquid deposition of the absorbent member (col. 15, lines 20-36).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Jacqueline R. Stephens  
Primary Examiner  
Art Unit 3761

January 22, 2007